

REMARKS

Claims 1, 27, 28, 42, 51, 54-58 and 61 are pending and rejected.

The specification has been amended to add the priority information.

Claims 1, 42, 54, 56, 58, 61 and claims dependent thereon, have been amended to recite the transgenic plants, methods, expression constructs and vectors contain or comprise microbial endo-1,3- β -glucanase or endo-1,4- β -glucanase. Support is in the specification on page 6, lines 31-32.

No new matter has been added by these amendments.

Priority

The Office Action states that the claim for priority cannot be based on a European Patent Application filed September 13, 1990 since it is more than 12 months prior to the filing of the US patent application.

Applicants have responded previously that this application is a continuation of US application no. 08/253,575, now US patent no. 5,705,375 which was a file wrapper continuation of US appl. no. 07/849,422, now abandoned which is the National Stage Appl. of International Application no. PCT/NL91/00171 that was filed in English and was published as WO92/05259. The specification has been amended to reflect this information.

Specification

The specification is objected to for incorporating essential material in the specification by reference to a foreign application or patent or an improper publication on page 16, lines 19 and 20.

Applicants respectfully disagree. The subject matter referred to is the gene sequence of the α -amylase gene from *Bacillus licheniformis* which is set forth in Figure 2. Therefore, the essential subject matter of the EP application no. 224,294 is already in the specification in Figure 2. No further amendment of the specification is deemed necessary.

Claim Rejection under 35 USC § 112, first paragraph

Claims 1, 27, 28, 42, 48, 51 and 54-58 remain rejected and claim 61 is rejected under 35 USC § 112, first paragraph, as allegedly not described in the specification.

Applicants respectfully disagree with this rejection, however, in order to advance prosecution of certain embodiments of the invention, the claims have been amended to recite the microbial endo-1,3- β -glucanase or endo-1,4- β -glucanase to more particularly point out and distinctly claim the present invention.

The above amendments and remarks overcome this rejection, and Applicants request its withdrawal.

Claim Rejection under 35 USC § 112, first paragraph

Claims 1, 27, 28, 42, 51, and 54-58 remain rejected and claim 61 is rejected under 35 USC § 112, first paragraph, as allegedly no being enabled. In particular, the Office Action contends that the specification does not teach how to predictably make and use transgenic plants comprising any microbial endo-glucanase wherein the saccharide composition of said plants is increased as broadly claimed without undue experimentation.

Applicants respectfully disagree with this rejection, however, in order to advance prosecution of certain embodiments of the invention, the claims have been amended to recite the microbial endo-1,3- β -glucanase or endo-1,4- β -glucanase to more particularly point out and distinctly claim the present invention.

The above amendments and remarks overcome this rejection, and Applicants request its withdrawal.

Claim Rejection under 35 USC § 102

Claims 1, 27, 28, 51, 54-58 and 61 are rejected under 35 USC § 102 as allegedly being anticipated by Borriss et al. (WO90/09436) taken with the evidence of Hofemeister et al. (1996, Gene, 49:117-187). In particular, the Office Action contends that

Claims 42 and 48 are free of the prior art.

Applicants respectfully disagree with this rejection, however, in order to advance prosecution of certain embodiments of the invention, the claims have been amended to recite the microbial endo-1,3- β -glucanase or endo-1,4- β -glucanase to more particularly point out and distinctly claim the present invention.

Borriss et al. taken with the evidence of Hofemeister et al. describe genetic constructs and transgenic plants comprising a microbial (1,3-1,4)- β -glucanase. This reference does not describe the presently claimed invention using microbial endo-1,3- β -glucanase or endo-1,4- β -glucanase. Therefore, Borriss taken with Hofemeister do not describe each and every element of the presently claimed invention, and do not anticipate.

The above amendments and remarks overcome this rejection, and Applicants request its withdrawal.

Double Patenting

Claims 1, 27, 28, 42, 51, 54-58 and 61 are rejected under the judicially created doctrine of double patenting over claims 1-17 of US Patent no. 5,705,375.

Claims 1, 27, 28, 42, 51, 54-58 and 61 are rejected under the judicially created doctrine of double patenting over claims 7, 10, and 11 of US Patent No. 5,543,576.

Upon allowance of subject matter of the claims, Attorney for Applicants will submit terminal disclaimers to overcome these rejections.


Conclusion

The above remarks and amendments put the application in form for finding allowable subject matter subject to filing the terminal disclaimers.

Respectfully submitted,

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